

REMARKS

This Amendment and the following remarks are intended to fully respond to the Office Action dated June 21, 2005. In that Office Action, claims 1-20 were examined, and all claims were rejected. More particularly, claims 7-13 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter because they are lacking utility; claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hafsteinsson et al. (US PG Pub 2004072484A1). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Response, claims 8-13 are amended and claim 7 has been cancelled. Therefore, claims 1-6 and 8-20 remain present for examination.

Claim Rejection – 35 U.S.C. § 101

Claims 7-13 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter because they are lacking utility. Claim 7 has been cancelled, and the rejection of claim 7 is now moot. Claims 8-13 have been amended into proper format and render the rejection moot.

Claim Rejection – 35 U.S.C. § 112

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 has been cancelled, and the rejection of claim 7 is now moot.

Claim Rejections - 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hafsteinsson et al. (US PG Pub 2004072484A1). Applicants respectfully traverse the § 103 rejections because the Hafsteinsson reference is not prior art under 35 U.S.C. § 102. A prima facie case of obviousness can only be established when all of the following requirements are

met: (1) there must be some suggestion or motivation in the references themselves to combine the references; (2) there must be a reasonable expectation of success; and (3) the reference or combination of references must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143. In addition, all prior art references used under 35 U.S.C. § 103 must be prior art under one or more sections of 35 U.S.C. § 102. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987) and MPEP § 2141.01.

The publication date of the Hafsteinsson reference is September 2, 2004, which is after the filing date, August 20, 2001, of the present application. Thus, the Hafsteinsson reference is not prior art under 35 U.S.C. §§ 102(a) or 102(b). As such, Examiner must be assuming that the Hafsteinsson reference is prior art under 35 U.S.C. § 102(e).

While the required section in the disclosure that claims priority to a parent application is missing from Hafsteinsson, it appears that Hafsteinsson claims priority to an earlier continuation-in-part application, No. 09/824,675, with a filing date of April 4, 2001 (hereinafter referred to as the "CIP application"). However, as proved in the last Office Action Response dated April 13, 2005, the present invention has a conception and an actual reduction to practice that predates September 6, 2000. Thus, for the same reasons as stated in the April 13, 2005 response, the Hafsteinsson reference is not prior art if accorded the filing date, April 4, 2001, of the CIP application.

While not stated in the Hafsteinsson reference, it appears that the CIP application claims priority to a provisional application, No. 60/194,695, which was filed April 5, 2000 (hereinafter referred to as the "provisional application"). Importantly, the priority date of the parent application can be accorded to the CIP (or child applications of the CIP) for only that material presented in the parent application. William Pordy v. Land O'Lakes, Inc., 97 Fed.Appx. 921, 929 (Fed. Cir. 2004). As the Examiner has failed to show that the information cited in Hafsteinsson was included in the provisional application, the Examiner has failed to establish that Hafsteinsson should be accorded the filing date of the provisional application. Since Hafsteinsson cannot be accorded the filing date of the provision application without such showing and is not prior art if accorded the filing date of the CIP application, Hafsteinsson is not prior art. Therefore, the present claims are allowable over Hafsteinsson.

Conclusion

This Amendment fully responds to the Office Action mailed on June 21, 2005. Still, that Office Action may contain arguments and rejections that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

A check in the amount of \$120 is enclosed to cover the fee for a Petition for Extension of time. It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Date: September 29, 2005



A handwritten signature in black ink, appearing to read "Tadd F. Wilson". The signature is fluid and cursive, written over a horizontal line.

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